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Attorney Docket No. 0756-1441

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 30 2004

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In re Patent Application of:

Shunpei YAMAZAKI

Serial No. 08/558,544

Filed: November 16, 1995

For: DEVICE FOR READING AN IMAGE

HAVING A COMMON

SEMICONDUCTOR LAYER

) Group Art Unit: 2811

) Examiner: D. Kang

) CERTIFICATE OF MAILING

) I hereby certify that this correspondence is  
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) Mail in an envelope addressed to:  
) Commissioner for Patents, P.O. Box 1450,  
) Alexandria, VA 22313-1450, on June 24,  
2004.

) Adelle M. Stamps

RESPONSE

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed March 24, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on February 20, 1996, December 11, 1997, December 28, 1999, and August 13, 2002.

Claims 1-4, 6, 7, 10-18, 20, 21, 23-28, 30, 32 and 34-59 are pending in the present application, of which claims 1, 7, 10, 15, 21, 23, 33, 36, 41, 43, 45 and 46 are independent. Although the Official Action states that claims 1-4, 6, 7, 10-18, 20, 21, 23-28, 30, 32 and 34-59 are allowed (page 3, Paper No. 46), it appears that claims 45 and 55 are rejected. Therefore, it appears that claims 1-4, 6, 7, 10-18, 20, 21, 23-28, 30, 32, 34-44, 46-54 and 56-59 are allowed. The Applicant notes with appreciation the allowance of these claims. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action states that the reissue oath/declaration "is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid." In response, the Applicant will submit a further *Supplemental Declaration and Power of Attorney for Reissue Patent Application* which includes all relevant statements required by the Rules as soon as it is complete and received from Japan. It is noted that although the above-referenced statement was not included in the *Supplemental Declaration and Power of Attorney for Reissue Patent Application* executed on January 23, 2001, the above-referenced statement was made in prior declarations.

Also, the Official Action states that a supplemental oath/declaration "stating that 'all errors' being corrected arose without deceptive intent ... is necessary to cover all the amendments made since the last supplemental oath/declaration filed February 5, 2001" (page 2, Paper No. 46). In response, as noted above, a *Supplemental Declaration* will be filed as soon as it is complete and received from Japan and will include all relevant statements required by the Rules. Reconsideration of the objection to the reissue oath/declaration is requested.

Paragraph 3 of the Official Action rejects claims 45 and 55 "as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee" (*Id.*). Initially, the Applicant notes that Dr. Shunpei Yamazaki is the sole inventor and patentee in the present application, and that Dr. Yamazaki signed all of the declarations in the present reissue application. Therefore, the Applicant respectfully submits that the present reissue application is made and sworn to by the patentee, Dr. Yamazaki.

Also, the Applicant respectfully disagrees with the above assertion that the present application has been improperly broadened. As stated in MPEP § 1412.03, under the heading "WHEN A BROADENED CLAIM CAN BE PRESENTED," "In addition, a broadened claim can be presented after two years from the grant of the original patent in a broadening reissue which was filed within two years from the grant.

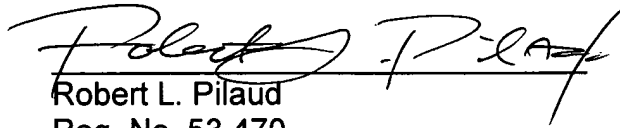
Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period” (emphasis added). The Applicant respectfully submits that the present application was filed within two years from the grant of U.S. Patent No. 5,262,654, and that a clear intent to broaden is indicated by the amendment of the claims in the present reissue at the time of filing, which was within two years of the patent grant.

Specifically, the present application was filed on November 16, 1995, which was the two-year anniversary of the grant of U.S. Patent No. 5,262,654. As noted in MPEP § 1412.03, a “reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant.” Therefore, the present application was clearly filed within 2 years of the patent grant. Further, the Applicant respectfully submits that a specific intent to broaden was indicated in the present application by the fact that the claims were amended at the time of filing the present application.

For example, in claim 1, “reading an image” was changed to “sensing a light,” “image” was changed to “light,” and “semi-amorphous” was deleted. These amendments are clearly broadening in nature, clearly express the intent of the Applicant to broaden the claims, and were filed within two years of the patent grant. Therefore, a broadened claim may be subsequently presented in the present reissue application after the two year period. Reconsideration of the rejection is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Robert L. Pilaud", written over a horizontal line.

Robert L. Pilaud  
Reg. No. 53,470

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